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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/815,727	03/23/2001	George Harry Hoffman	41556/04026 (RSIIP038)	8187
22428	7590	06/28/2004	EXAMINER	
FOLEY AND LARDNER SUITE 500 3000 K STREET NW WASHINGTON, DC 20007			GORT, ELAINE L	
			ART UNIT	PAPER NUMBER
			3627	

DATE MAILED: 06/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/815,727

Applicant(s)

HOFFMAN ET AL.

Examiner

Elaine Gort

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 1-6 and 13-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
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| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>9/7/01; 10/25/02</u> . | 6) <input checked="" type="checkbox"/> Other: <u>IDS: 1/23/03; 3/29/04</u> . |

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of claims 7-12 in Paper No. 3/29/04 is acknowledged.

Claims 1-6 and 13-18 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 12.

Double Patenting

2. Claims 7-12 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over all the claims filed in the following Applications because they are not patentably distinct:

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The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 7-12 are rejected because they lack patentable utility. Claims 7-12 merely claim the manipulation of data ("logic for") but perform no concrete, useful or tangible result. One example of how this rejection may be overcome by claiming the generation of a report or output of data.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 7-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 7 recites the limitation "the data for ordering sporting goods" in line 6.

There is insufficient antecedent basis for this limitation in the claim.

In claim 7 line 9 it is unclear what is being claimed relating to "the data". It is unclear as the term "data" is used in lines 3, 4, and 6 and it is unclear if this data is all referring to the same data.

In claim 7 line 11 it is unclear what is being claimed relating to "the data". It is unclear as the term "data" is used in lines 3, 4, 6 and 9 and it is unclear if this data is all referring to the same data.

In claim 7 line 13 it is unclear what is being claimed relating to "the data". It is unclear as the term data is used in lines 3, 4, 6 and 11 and it is unclear if this data is all referring to the same data.

In claims 8, 9, 10 and 12 it is also are unclear what is being claimed regarding to "the data" as claim 7 refers to data in lines 3, 4, 6, and 11 and it is unclear if this data is all referring to the same data or two types of data.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 7, 9, 10 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Shavit et al. (US Patent 4,799,156).

Shavit et al discloses the claimed system for managing a sporting goods supply chain utilizing a network, comprising:

Logic for receiving data from a plurality of sporting goods outlets of a sporting goods supply chain utilizing a network (see figure 2 which shows buyers in communication with a networked supply chain system that is capable of receiving data from a sporting goods outlet of a sporting goods supply chain, for example the buyer/sporting goods outlet enters information in a RFQ to obtain a quote/bid such as for sporting goods disclosed in column 13, lines 10+), the data relating to the sale of sporting goods by the sporting goods outlets (column 6, line 21 discusses the system being used for "goods" which by definition incorporates sporting goods);

Logic for generating an electronic order form based on the data for ordering sporting goods from a sporting goods distributor of the sporting goods supply chain (such as when the bid is converted to an order, column 13, lines 56+);

Logic for transmitting the data to the sporting goods distributor of the sporting goods supply chain utilizing the network (data from the buyer is transmitted to the distributor to get a RFQ and also to place the order, see figure 2, column 13 lines 10+ and lines 51+);

Logic for transmitting the data to a sporting goods supplier of the sporting goods supply chain utilizing the network (see figure 2 and column 11, line 15+ regarding sellers (distributors) communicating concurrently with suppliers);

Logic for forecasting activity in the sporting goods supply chain utilizing the data (column 7, line 19, Examiner contends that the forecasting disclosed would inherently be used to forecast activity within the supply chain utilizing data relating to the sale of goods, for example a buyer, distributor and/or supplier may forecast future needs and demand by evaluating trends in the data relating to the sale of goods);

(Regarding claim 9) Where the data is accessible to the sporting goods outlets, the sporting goods distributor, the sporting goods supplier via a network-based interface (such as shown in figure 2 and column 5, lines 50+ discloses public networks);

(Regarding claim 10) Where the data is accessible to the sporting goods distributor and the sporting goods supplier only after verification of an identity thereof (user id and passwords are used to identify users to validate access, column 9 lines 43-65 and column 10 lines 1-15); and

(Regarding claim 12) Where the sporting goods outlets, the sporting goods distributor, and the sporting goods supplier each forecast utilizing the data (column 7,

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lines 15+ discloses where the system is capable of providing users with forecasting capabilities).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 8 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shavit et al. (US Patent 4,799,156) in view of Microsoft Press Computer Dictionary.

(Regarding claim 8) Shavit et al. discloses the claimed system but is silent regarding how the data is specifically handled within the system and processed among the parties and thus is silent regarding parsing of the data. Microsoft Press Computer Dictionary, discloses that it is known in the art to parse data to break input into smaller chunks so that a program can act upon the information (see definition of "parse" on page 355). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the system of Shavit et al. with the parsing of data as taught by Microsoft Press Computer Dictionary, in order to break the data relating to sales into smaller chunks so that the system can act upon the information in sending it to distributors, suppliers, brokers, etc...

(Regarding claim 11) Shavit et al. discloses the claimed system but is silent regarding the use of the Internet. Microsoft Press Computer Dictionary discloses that it

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is known in the art to use the Internet for high-speed reliable communications (see definition of "Internet" on page 258). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the system of Shavit et al. with Internet access as taught by Microsoft Press Computer Dictionary, in order to provide users with high-speed reliable communications.

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elaine Gort whose telephone number is (703)308-6391. The examiner can normally be reached on Monday through Thursday from 7:00 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski, can be reached at (703)308-5183. The fax phone number for the organization where this application or processing is assigned is (703)305-7687.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-1113.



Elaine Gort
Examiner
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June 18, 2004